

O-279-07

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2408036
BY SAMSUNG ELECTRONICS CO., LTD TO REGISTER
THE TRADE MARK IMAGE BEYOND IMAGINATION IN CLASS 9**

AND

**IN THE MATTER OF OPPOSITION No. 94387
BY THOMSON**

TRADE MARKS ACT 1994

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Trade Mark IMAGE BEYOND IMAGINATION in Class 9**

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**IN THE MATTER OF Opposition No. 94387
by Thomson**

BACKGROUND

1. On 2 December 2005 Samsung Electronics Co., Ltd applied to register the mark **IMAGE BEYOND IMAGINATION** for goods that are described as ‘CIS (CMOS-Image Sensors)’.
2. On 2 June 2006 Thomson filed notice of opposition to this application citing a single ground under Section 5(2)(b) of the Act. Thomson is the proprietor of Community Trade Mark No. 4860391 for the mark **IMAGE AND BEYOND**. It is registered in four Classes, namely 9, 35, 38 and 41. The opponent’s statement of grounds refers in particular to the Class 9 specification which it says includes numerous items relating to video technologies. The applicant’s goods are said to be part of such technology. I should add that registration No. 4860391 has a filing date of 18 January 2006 which is after the filing date of the application in suit. However, it has a (French) priority claim of 2 August 2005 that is shown as having been accepted.
3. The applicant filed a counterstatement that denies the above claim and offers certain submission in relation to both the marks, the goods and the issue of likelihood of confusion.
4. Only the opponent has filed evidence. By letter dated 10 July 2007 the parties were invited to say whether they wished to be heard or to file written submissions. Neither side has asked to be heard. The opponent has filed written submissions under cover of a letter from Mewburn Ellis, its professional advisers, dated 21 August 2007. After a careful study of the papers I give this decision.

Opponent’s evidence

5. Michael Gregory Foster, a trade mark attorney with Mewburn Ellis LLP has filed three witness statements. The first dated 13 February 2007 exhibits (MGF1) dictionary definitions of the words **IMAGE**, **IMAGINATION** and **BEYOND** and a copy of the decision in a French opposition case involving the parties (MGF2) along with a translation thereof. A further exhibit (MGF3) confirms that the decision on the equivalent French application was not appealed. The second witness statement dated 27 March 2007 exhibits (MGF4) certified copies of the French opposition decision and translation thereof. The third witness statement dated 10 May 2007 exhibits (MGF5) a certified copy of the French decision endorsed by the Court of Appeal in Paris confirming that no appeal was submitted (MGF6). Finally exhibits MGF7 and 8

contain further material confirming that the applicant, Samsung Electronics Co., Ltd is now out of time for any appeal to be lodged.

DECISION

6. The single ground of objection is under Section 5(2)(b).

7. Section 5(2)(b) reads:

“(2) A trade mark shall not be registered if because –

(a)

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

8. Section 6(1)(a) defines an earlier trade mark as follows:-

“6. - (1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,”

9. In this case the opponent’s registration is an earlier trade mark by virtue of the priority claim of 2 August 2005. The opponent is not subject to the requirement to show proof of use of this mark under the provisions of The Trade Marks (Proof of Use, etc) Regulations 2004.

10. An objection under Section 5(2)(b) requires me to consider whether there are similarities in the marks and similarities in the goods that cumulatively, lead to a likelihood of confusion. The leading guidance from the European Court of Justice is contained in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] E.T.M.R. 723.

Comparison of Goods

11. The respective sets of goods are as follows taking the opponent’s Class 9 goods only, this being the most relevant Class. Within the Class 9 specification I have highlighted in bold the particular items referred to by the opponent in its written submissions.

Applicant's	Opponent's
CIS (CMOS-Image Sensors)	<p>Class 09:</p> <p>Apparatus for the recording, broadcasting, transmission, generation, reproduction and transformation of data, sound or images; apparatus for the gathering and processing of sound or images; apparatus for the amplification, modulation, detection, remote transmission and remote control; magnetic data carriers; photographic apparatus; editing appliances for cinematographic films, decoders, encoders; television screens, multimedia displays; apparatus for recording or reproducing television signals on discs or any other media, and components therefor; cameras, video cameras, television cameras and cinema cameras; video cassette recorders and video cassette apparatus; readers/recorders for video cassettes and/or compact discs and/or digital audio and video discs, videograms, including cassettes, discs and video discs, recorded or otherwise; gramophone records; remote controls, hi-fi systems, radio cassettes, loudspeaker systems, amplifiers; tape recorders, personal stereos, headphones with cord or cordless; corded and cordless telephones; telephone answering machines; dictating machines; radioelectric aerials, including television aerials and parabolic aerials; video transmitters, mixing machines, video servers; computer software to enable the encoding and decoding of audio and video data; electric wires and cables, in particular coaxial cables; screens for photographic or cinematographic projection; recording apparatus and installations, namely those using audiovisual means; and, in general, transmission apparatus and instruments of all kinds, including by radio, cable or satellite allowing interaction.</p>

12. The established tests for assessing similarities in goods and services are to be found in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (supra) and *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281. These require consideration of inter alia, nature, intended purpose, method of use, whether the goods are in competition with each other or are complementary as well as users and channels of trade.

13. The applied for specification is brief in content but cryptic in terms of meaning. As the applicant has not engaged in these proceedings in terms of filing evidence or written submission I have had no assistance on the point beyond the observation (in response to one of the opponent's claims) that "parts or fittings of goods are not necessarily the same as or similar to those goods themselves"; the denial that the goods are identical or similar; and the claim that the markets and consumers are different.

14. I infer that CIS is an acronym formed from the initial letters of CMOS-Image Sensors. Some light is shed on the probable meaning of CMOS in the judgment in the opposition proceeding in France where the same goods were in play. It stands for

complementary metal oxide semi-conductor image captors. I note that the translation of that judgment explains that the goods

“are understood as chips transforming luminous energy into electrical charges which are then converted into digital information in order to record and to reconstitute images are intended to equip “devices for recording, generating and transforming images, devices for collecting and processing images, photographic devices, cameras, video cameras, television cameras and cinema cameras” of the earlier trade mark invoked;”.

15. It is not entirely satisfactory to have to interpret a specification in this way. I feel justified in doing so for two reasons. Firstly, the earlier trade mark relied on in the French opposition proceedings (No. 53373695) is the one referred to in OHIM’s records as providing the basis for the Community Trade Mark priority claim (and the specifications are, some nuances of translation apart, the same). Secondly, if the position should be considered different in the UK it was open to the applicant to deal with the matter through evidence or submissions. It has not done so.

16. The opponent’s goods cover a wide range of items but include apparatus for the gathering, recording and processing of images. The specification does not use the term sensing. Had that been so there would be no doubt that identical goods were involved. Nevertheless the process of sensing an image is a closely connected one and a prelude to, or part of, the other functions of recording, gathering, processing etc. Thus, for instance, a DVD player senses the image on the DVD itself and converts it into an image that can be displayed on a television screen. These are technologies and functions that are closely associated and complementary to one another and an essential part of apparatus and equipment that employ such technologies and functionality. If the terminology used in the opponent’s specification does not actually include image sensing equipment or image sensors (as a component) then I would nevertheless hold that they are technologically and commercially closely similar.

17. I should just add that the opponent’s specification includes “apparatus for the amplification, modulation, detection, remote transmission and remote control;”. The use of the definite article before ‘amplification’ suggests that it may have been intended to complete the list with a description of what it was that was to be the subject of the functionality concerned. As it stands the specification appears to be incomplete. The point is not merely of academic interest because “apparatus for....detection..” would in my view be broad enough to include a sensing function and hence point to identical goods.

Comparison of marks

18. The opponent has referred to the dictionary meanings of the words IMAGE, IMAGINATION and BEYOND and the finding of the French Office (INPI) that the applied for mark constituted an imitation of the earlier trade mark. It is said that taking into account imperfect recollection one mark is likely to be confused with the other. The applicant for its part claims that the marks differ phonetically, visually and conceptually.

19. The opponent invites me to take account of the judgment of the French Office. In support of its position it places reliance on a passage from *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* [2006] F.S.R. 30 at page 544 where the Court of Appeal found that “Litigation in other jurisdictions has so far yielded a clutch of helpful judgments on this point from national courts The foreign judgments speak with one voice, though in different languages”.

20. Helpful though that submission and case might appear at first glance in supporting the view that decisions in other jurisdictions are relevant, it fails to note the particular issue and circumstances that the Court of Appeal had before it, namely the law as it should be applied to shape marks (where at the very least linguistic differences and nuances of meaning do not hamper cross-jurisdictional comparison). Even here, the Court of Appeal was not suggesting that decisions in other jurisdictions were determinative.

21. For the reasons given by the Appointed Person in *Zurich Private Banking*, BL O/201/04 referring to *Henkel KGaA v Deutsches Patent-und Markenamt*, Case C-218/01 different national offices are not competent to adjudicate on the correctness of each other’s determinations and are not required to treat each other’s determinations as binding. The Appointed Person went on to say:

“That is not to say that each of them should or will simply ignore determinations of the others. The general principle is that each of them should give determinations of the others such weight (if any) as they might fairly and properly be said to bear in the decision-taking process they are required to undertake independently of one another.”

22. Those observations like the *Philips* case arose in the context of an absolute ground objection. Particular care is needed when, as here, the issue is a relative grounds one. As the Appointed Person noted in the *Zurich Private Banking* case “it is clearly recognised and accepted in Community Law that the meaning and significance of a designation may vary from one member state to another as a result of linguistic, cultural and social differences between their populations”. That is pointedly the case where the French Office was considering the impact of English language marks on the average consumer in France. In those circumstances the particular shadings of meaning represented by the composite expressions may be different (compared to a UK audience) even if the literal meaning of the words themselves that make up those expressions was understood. I am required to approach the marks from the perspective of the average consumer in this country.

23. The marks are IMAGE BEYOND IMAGINATION and IMAGE AND BEYOND. The comparison must take account of visual, aural and conceptual similarities and differences.

24. The word IMAGE appears in both marks. As the dictionary material at MGFI shows the word has numerous meanings including the likeness of a person, an optically formed reproduction of an object, a mental representation or picture etc. In the context of the goods at issue the word has a technical meaning namely a device (a sensor, photocell or such like) that detects images etc. For goods that are, or would

include, image sensors the word cannot be considered to be a dominant or distinctive component of either mark.

25. The word BEYOND requires little explanation or elaboration. As the dictionary material shows it means ‘at or to a point on the other side of’, ‘outside the limits of’ etc.

26. IMAGINATION means ‘the faculty or action of producing ideas especially mental images’, ‘mental creative ability’ etc.

27. Helpful though it is to have an understanding of the elements that make up marks, it is always the case that marks must be considered as wholes without artificial dissection. Both the marks here are composed of relatively well known words. In the case of the marks at issue here it is the concept or message that they create that is in my view the key to the comparison. Both allude to the fact that they are something to do with images. They hint at some additional but unstated function, quality or capability. They do so in a cryptic or allusive way. The marks do not yield a clear meaning. But that does not prevent them sharing a similar aspirational message that ‘here are products that go beyond your expectations or imagination in terms of the images they will produce’. I, therefore, find a reasonably high degree of conceptual similarity in the marks. That conceptual similarity finds a strong visual and verbal echo in the common use of the words IMAGE and BEYOND to send out their respective messages. Against that the applied for mark has the word IMAGINATION and lacks the conjunction AND. But the word IMAGINATION also plays in part on the ‘image’ theme (see the above dictionary definition). Taking all these factors into account I find that the similarities between the marks outweigh the differences. The marks are similar to a significant, but not the highest, degree.

Distinctive character of the earlier trade mark

28. It is well established that there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character either per se or because of the use that has been made of it (*Sabel v Puma*, paragraph 24). The distinctive character of a mark determines the protection afforded to that mark and is to be distinguished from the notion of the distinctive character that an element possess within a composite mark (see Case C-235/05P *L’Oreal SA v OHIM*). I have already indicated that the element IMAGE cannot be held to be a dominant or distinctive element within the mark IMAGE AND BEYOND. It is merely part of the overall message. However, the message is vague and incomplete. It hints at some desirable quality but without conveying a clear descriptive message. I find that those qualities point to a mark deserving of a moderate degree of protection based on its inherent distinctiveness. However, given that the words used are ordinary words of the language and that the combination does not display a particularly high degree of invention, I am unwilling to put it higher than that.

The average consumer

29. Given the breadth of the opponent’s specification and the indirect assistance (from the French decision) that I have had to rely on in reaching an understanding of the applicant’s goods, it is not an easy matter to determine who will constitute the

average consumer or whether there is likely to be more than one group of consumers. It strikes me that the applicant's goods are more likely to be components of finished products and may, therefore, be sold to original equipment manufacturers or other traders. However, depending on issues to do with servicing of products and the process of installing replacement parts it may be that retailers and even end consumers will come into contact with the goods.

30. Some of the relevant items of apparatus and equipment set out in the opponent's specification may be for manufacturing/industrial use but other products that can be expected to contain image sensors, such as cameras, may find more general usage in the ordinary consumer market.

31. Accordingly, I must allow for a variety of users, a variety of circumstances of trade and varying degree of knowledge and product awareness amongst consumer groups. Industrial customers purchasing on a regular basis can be expected to have a higher level of knowledge and discrimination than irregular customers amongst groups such as retailers, equipment servicers and end consumers.

Likelihood of confusion

32. An assessment of the likelihood of confusion involves a synthesis of the various elements considered above. Central to the assessment is the concept espoused in *Canon* (paragraph 17) that a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods and vice versa. I have found that the goods are closely similar, that the marks are (moderately) similar and that the earlier mark is of moderate distinctiveness. In Case T-112/03, *L'Oreal SA v OHIM*, the CFI rejected a claim by the applicant that where a mark was held to be of weak distinctive character only a complete reproduction of the earlier mark could give rise to a likelihood of confusion. The ECJ subsequently handed down a reasoned order rejecting the appeal and accepting the CFI's approach in relation to the marks (Case C-235/05P referred to above).

33. I bear in mind that the applicant's goods may be components and hence purchased by original equipment manufacturers. The latter are likely to be very knowledgeable and, exercising the qualities attributed to consumers in *Lloyd Schuhfabrik*, may be less prone to confusion. However, there is no basis for considering that the circumstances of trade will be restricted in this way. Other user groups may purchase imaging apparatus from the opponent and image sensors from the applicant in circumstances where they have not previously encountered the marks. They may also be purchasing on an irregular basis in circumstances where, as the opponent's written submissions remind me, imperfect recollection can be expected to play a part. Weighing these factors in the balance I find that there is a likelihood of confusion and the opposition succeeds under Section 5(2)(b).

Costs

34. The opponent is entitled to a contribution towards its costs. I order the applicant to pay the opponent the sum of **£1200**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 24th day of August 2007

M REYNOLDS
For the Registrar
the Comptroller-General